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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

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FARKAS & MANELLI PLLC  
2000 M STREET NW  
7TH FLOOR  
WASHINGTON, DC 200363307

EXAMINER
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BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

16

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/349,708

Applicant(s)

BERTHOUD ET AL.

Examiner

Bing Q Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-44 is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-44 are presented for examination.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1-5, 8-15, 17-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of Bull et al (US Pat No. 6,498,841), herein after referred as Smock and Bull.

**Regarding claim 1**, with respect to Figure 1, Smock teaches the invention as claimed, a system for notifying a called-but-busy party 16 of an incoming telephone call attempt over a telephone line while the called-but-busy party 16 is accessing the Internet over the same telephone line 50, comprising:

Internet communication module (Fig 1, element 68 and col 3, ln 8-34); and

a message formatter (Fig 1, element 64 and col 3, ln 66-col 4, ln 4);

wherein said Internet communication module is adapted to cause said message formatter to send a notification message (e.g. announcing the name and telephone number of the caller) to said called-but-busy party upon request from a caller (remote telephone user) (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22)..

Smock fails to teach the message sent to the called-but-busy party is a personalized notification recorded by a remote telephone user or caller. However, Bull teaches a system that provides an enhanced call message for notifying a call waiting to a called-but-busy party, wherein the call message is spoken caller identification

information (e.g., personalized message or notification) input by the caller into the system (e.g., caller records his personalized message or notification in to the system), and then the spoken caller identification message is then audibly provided to the called-but-busy party (see col. 3, lns 51-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate a spoken caller identification message (e.g., a personal notification message) for the called-but-busy party input by the caller, as taught by Bull, into communication system of Smock in order to enable the busy-internet user to decide how to treat the waiting call.

**Regarding claim 2**, with respect to Figure 1, Smock teaches the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1 (Fig 1 and Abstract); Smock et al do not explicitly teach ,the remote telephone user is a central office; however, as it can be seen by an ordinary skill in the art, an incoming call transparently comes from a different or the same central office with the called-but-busy party via phone line 10 (Fig 1 and col 3, ln 8-45).

**Regarding claim 3**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line 50 while the called-but busy party is accessing the Internet over the same telephone line 50 according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Fig 1 and col 2, ln 28-40).

**Regarding claim 4**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver 32 (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4);

wherein call related information regarding a calling party is included with said notification message (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 5**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 8**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 9**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly playable data file automatically plays when received on a computer terminal of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 10**, with respect to Figure 1, Smock teaches the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 11**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**As to claims 12 and 18**, they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 12 and 18 are merely a method of operation for the system defined in the system claim 1.

**Regarding claim 13**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising

receiving a notification request from said calling party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 14**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 15**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 17**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is an audibly playable message (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**As to claims 19-22** , they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

**As to claim 24**, it is rejected for the same reasons set forth to rejecting claim 8.

**As to claim 25**, it is rejected for the same reasons set forth to rejecting claim 1.

3. Claims 6-7, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock (US Pat No. 6,377,668) in view of Bull (US Pat No. 6,498,841), and further in view of Bajzath (US Pat No. 6,144,644), herein after referred as Bajzath.

**Regarding claims 6-7, 16 and 23**, the combined system of Smock and Bull teaches the invention substantially as claimed, with the exception of providing the notification message sent to an internet user and displayed on internet user's computer terminal in the form of text. However, Bajzath teaches the notification message sent to an internet user and displayed on internet user's computer terminal in the form of text (see Fig. 6A, steps "650"- "660" and col. 6, lns 33-41). Therefore, integrating Bajzath's teachings into the combined system of Smock and Bull would have been obvious for providing internet user more flexibility in receiving the call waiting notification.

#### ***Allowable Subject Matter***

4. Claims 26-44 are allowed.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.



**Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malik (US Pat. No. 6,301,349) discloses a method and system for connecting an unanswered forwarded communication directly to a voice mail service.

Infosino (US Pat. No. 6,343,121) discloses a selective call waiting service.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Dec 20, 2003

**BING BUI**  
**PATENT EXAMINER**